

Application No.: 10/797,765
Amendment Dated October 29, 2010
Reply to Official Action of October 7, 2010

REMARKS/ARGUMENTS

This Amendment is being filed in response to a fourth (and now non-final) Official Action issued following a decision on a Pre-Appeal Brief Request for Review to re-open prosecution. The Official Action rejects Claims 1-4, 7-12, 14, 16-21, 23, 25-30, 32-39, 43-48 and 52-54 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0064164 to Barany et al. The Official Action then rejects Claims 5, 13, 22, 31, 40 and 49 under 35 U.S.C. § 103(a) as being unpatentable over Barany, in view of U.S. Patent Application Publication No. 2004/0156380 to Silverman et al.; and the remaining claims, namely Claims 6, 15, 24, 33, 42 and 51, as being unpatentable over Barany, in view of U.S. Patent Application Publication No. 2005/0210292 to Adams et al.

As explained below, Applicant respectfully submits that the claimed invention is patentably distinct from Barany, Silverman and Adams, taken individually or in any proper combination. Nonetheless, Applicant has amended various ones of the claims to further clarify the claimed invention. In view of the amendments to the claims and the remarks presented herein, Applicant respectfully request reconsideration and allowance of all of the pending claims of the present application.

A. Claims 1-4, 7-12, 14, 16-21, 23, 25-30, 32-39, 43-48 and 52-54 are Patentable

The fourth Official Action rejects Claims 1-4, 7-12, 14, 16-21, 23, 25-30, 32-39, 43-48 and 52-54 as being anticipated by Barany.

I. Claims 1-9, 19-27 and 37-45 are Patentable over Barany

Relative to independent Claim 1 (and similarly independent Claims 19 and 37), Applicants presume the Official Action alleges the following correspondence between independent Claim 1 and Barany, citing FIGS. 1 and 3, and paragraphs [0023], [0062] and [0063] of Barany.

Claim 1	Barany
As an apparatus comprising: a processor; and a memory including computer program code, the memory and computer program code configured to, with the processor, cause the apparatus to at least:	Call state control function (CSCF) module 40
receive a connection request via a network across which an originating client is configured to communicate;	[0023] ... In some embodiments, the CSCF module 40 is a (Session Initiation Protocol) SIP proxy or server that receives call requests on behalf of other entities, resolves logical addresses or identifiers in the call requests, and forwards the call requests to intended destinations. ...
prepare a network- independent trigger for transmission to a terminal in response to receipt of the connection request; and	[0063] After SIP registration, the mobile station can initiate a packet-switched call by sending call setup messages (at 108). To initiate a call, the SIP INVITE request is sent, which includes the destination address of the terminal being called and indicates that the called terminal is being invited to participate in a call session. Various acknowledgment messages, as defined by SIP, are also exchanged between the mobile station and the CSCF 40. The SIP messages are routed through the CSCF 40 since the CSCF 40 acts as the SIP proxy.
receive a registration message, in response to the trigger, from the terminal via the network to thereby register the terminal with the apparatus and acquire a network- dependent identity of the terminal to thereby enable establishment of a communication session with the terminal based upon the network- dependent identity of the terminal.	[0062] After the primary PDP context has been activated, a SIP registration procedure is performed (at 106). The SIP registration procedure is performed with the CSCF 40, which includes the SIP proxy. SIP registration is performed to set up the profile for the mobile station in the CSCF 40, so that the CSCF 40 is aware of the mobile station's existence as well as various configuration information associated with the mobile station.

(a) Network-Independent Trigger

In contrast to independent Claim 1, Barany does not teach or suggest an apparatus being caused to prepare a network-independent trigger for transmission to a terminal in response to receipt of a connection request. The Official Action cites the SIP INVITE of paragraph [0063]

of Barany for allegedly disclosing this feature. However, Applicant notes that nowhere does Barany disclose that its SIP INVITE is prepared for transmission “in response to receipt of a connection request;” instead, Barany’s SIP INVITE is a connection request. *See Barany, para. [0063]* (“To initiate a call, the SIP INVITE request is sent”). Accordingly, Barany also does not disclose that its SIP INVITE is independent of the network via which a connection request is received, i.e., “network-independent.” Moreover, Barany does not disclose that its SIP INVITE is prepared for transmission to the terminal from which a registration message is received. In Barany, the SIP INVITE is transmitted from the mobile station that registered with the CSCF.

For at least the foregoing reasons, the SIP INVITE of Barany does not correspond to a trigger similar to that of amended independent Claim 1.

(b) Registration Message

In further contrast to independent Claim 1, Barany does not teach or suggest an apparatus being caused to receive a registration message, in response to the network-independent trigger, via the network to thereby register the terminal with the apparatus and acquire a network-dependent identity of the terminal. The Official Action cites the SIP registration procedure of paragraph [0062] of Barany for allegedly disclosing this feature. However, Applicant notes that nowhere does Barany disclose that its SIP registration procedure occurs or that any registration message is received in response to the SIP INVITE – similar to the recited receipt of a registration message “in response to the network-independent trigger.” In fact, Barany explicitly discloses that SIP registration occurs before (not in response to) its SIP INVITE (alleged trigger) is sent. *See Barany, para. [0063]* (“After SIP registration, the mobile station can initiate a ... call To initiate a call, the SIP INVITE request is sent”).

2. Claims 10-18, 28-36 and 46-54 are Patentable over Barany

Relative to independent Claim 10 (and similarly independent Claims 28 and 46), Applicants presume the Official Action alleges the following correspondence between independent Claim 1 and Barany, citing FIGS. 1 and 3, and paragraphs [0023], [0062] and [0063] of Barany.

Claim 10	Barany (annotated per the Official Action)
An apparatus comprising: a processor; and a memory including computer program code, the memory and computer program code configured to, with the processor, cause the apparatus to at least:	Call state control function (CSCF) module 40
receive a registration message via a network across which an originating client is configured to communicate, wherein the apparatus being caused to receive a registration message comprises the apparatus being caused to receive a registration message from a terminal to thereby register the terminal with the apparatus, and	[0062] After the primary PDP context has been activated, a SIP registration procedure is performed (at 106). The SIP registration procedure is performed with the CSCF 40, which includes the SIP proxy. SIP registration is performed to set up the profile for the mobile station in the CSCF 40, so that the CSCF 40 is aware of the mobile station's existence as well as various configuration information associated with the mobile station.
wherein the registration message includes a network-independent identity of the terminal; and	“[A] SIP proxy ... registers the calling and called parties, handling the IP addresses required for packet switched communication; these IP address [sic] are independent of the circuit-switched cellular network, on behalf [sic] of which the CSCF SIP proxy receives and handles those packet-switched call requests.” Official Action of Oct. 7, 2010, pp. 6-7.
prepare a network-independent trigger for transmission to the terminal based upon the network-independent identity of the terminal to thereby trigger the terminal to update registration of the terminal with the apparatus, including acquisition by the apparatus of a network-dependent identity of the terminal to thereby enable establishment of a communication session with the terminal based upon the network-dependent identity of the terminal.	[0063] After SIP registration, the mobile station can initiate a packet-switched call by sending call setup messages (at 108). To initiate a call, the SIP INVITE request is sent, which includes the destination address of the terminal being called and indicates that the called terminal is being invited to participate in a call session. Various acknowledgment messages, as defined by SIP, are also exchanged between the mobile station and the CSCF 40. The SIP messages are routed through the CSCF 40 since the CSCF 40 acts as the SIP proxy.

In contrast to independent Claim 10, Barany does not teach or suggest an apparatus being caused to at least prepare a network-independent trigger for transmission to a terminal based upon a network-independent identity of the terminal to thereby trigger the terminal to update its registration with the apparatus, including acquisition by the apparatus of a network-dependent identity of the terminal to thereby enable establishment of a communication session with the terminal based upon the network-dependent identity of the terminal. The Official Action cites the SIP INVITE of paragraph [0063] of Barany for allegedly disclosing this feature; and for other features of independent Claim 10, cites GSM as the received network via which a registration message is received, and cites an IP address of a mobile station as the recited network-independent identity.

In contrast to the assertions in the Official Action, Applicant notes that nowhere does Barany disclose that the SIP INVITE is independent of the network (alleged GSM) via which the registration message is received, i.e., “network-independent.” Barany also does not disclose that its SIP INVITE is prepared for transmission to the terminal from which a registration message is received. In Barany, the SIP INVITE is transmitted from the mobile station that registered with the CSCF. Further, nowhere does Barany disclose that its SIP INVITE triggers the mobile station “to update registration” of the mobile station (alleged terminal) with the CSCF (alleged apparatus). Other than disclosing that the SIP INVITE is sent after SIP registration, nowhere does Barany disclose that its SIP INVITE has any affect on SIP registration. Moreover, nowhere does Barany disclose acquisition of a GSM-dependent identity (network-dependent identity, GSM being the alleged network) of the mobile station to enable establishment of a communication session with the mobile station based on the GSM-dependent identity (network-dependent identity), similar to independent Claim 10.

Applicant therefore respectfully submits that amended independent Claim 1, and by dependency Claims 2-9, is patentably distinct from Barany. Applicant also respectfully submit that amended independent Claims 10, 19, 28, 37 and 46 recite subject matter similar to that of independent Claim 1, including the aforementioned triggering the terminal (or an apparatus) or identifying the terminal (or an apparatus) independent of the network for which a communication session may ultimately be established. As such, Applicant also respectfully submits that

amended independent Claims 10, 19, 28, 37 and 46, and by dependency Claims 11-18, 20-27, 29-36, 38-45 and 47-54, are patentably distinct from Barany for at least the same reasons given above with respect to amended independent Claim 1.

For at least the foregoing reasons, Applicant respectfully submits that the rejection of Claims 1-4, 7-12, 14, 16-21, 23, 25-30, 32-39, 43-48 and 52-54 as being anticipated by Barany is overcome.

B. Claims 5, 13, 22, 31, 40 and 49 are Patentable

The Official Action rejects Claims 5, 13, 22, 31, 40 and 49 as being unpatentable over Barany, in view of Silverman. As explained above, independent Claims 1, 10, 19, 28, 37 and 46, and by dependency Claims 2-9, 11-18, 20-27, 29-36, 38-45 and 47-54, are patentably distinct from Barany. Applicant respectfully submits that Silverman does not cure the deficiencies of Barany. That is, even considering Silverman, neither Barany nor Silverman, taken individually or in any proper combination, teaches or suggests the aforementioned terminal-triggering feature, as recited by the claimed invention. And there is no apparent reason for one skilled in the art still to modify Barany with the teachings of Silverman in an effort to obviate the claimed invention. Thus, for at least the foregoing reasons as well as those given above with respect to amended independent Claims 1, 10, 19, 28, 37 and 46, Claims 6, 15, 24, 33, 42 and 51 are also patentably distinct from Barany, in view of Silverman.

Applicant accordingly submit that the rejection of Claims 5, 13, 22, 31, 40 and 49 as being unpatentable over Barany, in view of Silverman is overcome. *Claims 6, 15, 24, 33, 42 and 51 are Patentable*

The Official Action rejects Claims 6, 15, 24, 33, 42 and 51 as being unpatentable over Barany, in view of Adams. As explained above, independent Claims 1, 10, 19, 28, 37 and 46, and by dependency Claims 2-9, 11-18, 20-27, 29-36, 38-45 and 47-54, are patentably distinct from Barany. Applicant respectfully submits that Adams does not cure the deficiencies of Barany. That is, even considering Adams, neither Barany nor Adams, taken individually or in any proper combination, teaches or suggests the aforementioned terminal-triggering feature, as recited by the claimed invention. And there is no apparent reason for one skilled in the art still to

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modify Barany with the teachings of Adams in an effort to obviate the claimed invention. Thus, for at least the foregoing reasons as well as those given above with respect to amended independent Claims 1, 10, 19, 28, 37 and 46, Claims 6, 15, 24, 33, 42 and 51 are also patentably distinct from Barany, in view of Adams.

Applicant accordingly submit that the rejection of Claims 6, 15, 24, 33, 42 and 51 as being unpatentable over Barany, in view of Adams is overcome.

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CONCLUSION

In view of the amendments to the claims and the remarks presented above, Applicant respectfully submits that the present application is in condition for allowance. As such, the issuance of a Notice of Allowance is therefore respectfully requested. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicant's undersigned attorney in order to resolve any remaining issues.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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